

Application No. 10/715,912

REMARKS

Claims 29-35 are pending.

Claim Rejections Under 35 USC §112, First Paragraph

1. The Office Action Fails to Establish A Prima Facie Case That Claims 29-35 Lack Written Description Support.

Claims 29-35 were rejected under 35 USC §112, first paragraph, as failing to comply with the written description requirement. This rejection is respectfully traversed. MPEP §2163 A states,

“A description as filed is presumed to be adequate, unless or until sufficient evidence or reasoning to the contrary has been presented by the examiner to rebut the presumption. See, e.g., *In re Marzocchi*, 439 F.2d 220, 224, 169 USPQ 367, 370 (CCPA 1971). The examiner, therefore, must have a reasonable basis to challenge the adequacy of the written description. The examiner has the initial burden of presenting by a preponderance of evidence why a person skilled in the art would not recognize in an applicant's disclosure a description of the invention defined by the claims. *Wertheim*, 541 F.2d at 263, 191 USPQ at 97. In rejecting a claim, the examiner must set forth express findings of fact regarding the above analysis which support the lack of written description conclusion.” (emphasis added).

Claims 29-35 were first rejected under 35 USC §112, first paragraph in the Office Action dated, April 11, 2006. However, neither the April 11, 2006 Office Action nor the present Office Action dated July 21, 2006 establishes a *prima facie* case that the claims lack written description support by providing reasons why a person skilled in the art at the time the application was filed would not have recognized that the inventor was in possession of the invention as claimed in view of the disclosure of the application as filed as stated in MPEP §2163 III. A(B). Here, the Office Action provides no reasons or findings of fact whatsoever as

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to why a person skilled in the art at the time the application was filed would not have recognized that the inventor was in possession of the invention as claimed in view of the disclosure of the application as filed. Because the Office Action fails to establish a *prima facie* case that claims 29-35 lack written description support in the application as filed, the rejection under 35 USC §112, first paragraph is respectfully traversed and Applicant requests the rejection be withdrawn.

2. The Specification Supports Claims 29-35.

The Office Actions dated April 11, 2006 and July 21, 2006 both state that the application as filed does not include written support for the claim term, "not suffering from depression." However, for example, the specification states, "Still another principle object of the present invention is the provision of a comprehensive pharmacological therapy for treatment of obesity which is effective for all patients attempting to lose weight." Spec. p.3 ln 14-16 (emphasis added). Further, the specification states, "The use of Citalopram, Phentermine, and Diethylpropion in conjunction with nutritional supplements in effective dosing ranges generally achieves acceptable weight loss performance for all patients....." Spec. p. 6 ln 24-26 (emphasis added). The term "all patients" clearly encompasses those patients with or without depression. MPEP §2173.05(i) and the case law cited therein, states that alternative elements that are positively recited in the specification may be explicitly excluded in the claims. That is,

"[The] specification, having described the whole, necessarily described the part remaining."

Ex parte Parks, 30 U.S.P.Q.2d 1234 (Bd. Pat. App. & Inter. 1993). Here, there can be no doubt that the specification discloses that the method to facilitate weight loss is effective for all patients and that a patient suffering from depression is an alternative disease, condition, or problem that is positively recited in the specification, and therefore can be explicitly excluded via a negative

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limitation in the claims. "The notion that one who fully discloses, and teaches those skilled in the art how to make and use, a genus and numerous species therewithin, has somehow failed to disclose, and teach those skilled in the art how to make and use, that genus minus two of those species, and has failed to satisfy the requirements of §112, first paragraph, appears to result from a hypertechnical application of legalistic prose relating to that provision of the statute." Ex parte Kosley, 2002 WL 130547 (Bd. Pat. App. & Inter.). Accordingly, the disclosure meets the written description requirement in that it reasonably conveys to one skilled in the relevant art that the Applicant, at the time of the application was filed, had possession of the claimed method to facilitate weight loss from a patient not suffering from depression and the rejection should be withdrawn.

3. Full Faith and Credit is Given to Previously Allowed Claims

Pursuant to MPEP §706.04, full faith and credit should be given to the search and action of a previous Examiner unless there is a clear error in the previous action or knowledge of other prior art. In addition, MPEP §704.01 states that, "when an examiner is assigned to act on an application which has received one or more actions by some other examiner, full faith and credit should be given to the search and action of the previous examiner unless there is a clear error in the previous action or knowledge of other prior art." (emphasis added). Here, the claim term at issue was added at the suggestion of an Examiner and has been included in 4 related issued patents. Also, the Supervisory Examiner on the present application, Sreeni Padmanabhan, was the same Supervisory Examiner on this application's parent case, U.S. Patent No. 6,660,777. The '777 patent issued with the claim term, "not suffering from depression." The Office Action

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presents no clear error as to the findings of the Examiners in the four issued U.S. Patents that the application includes written support for the term, "not suffering from depression," and therefore full faith and credit should be given and the rejection under 35 USC §112, first paragraph should be withdrawn.

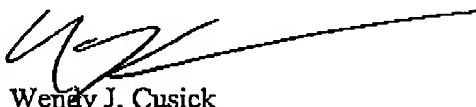
Provisional Rejection for Nonstatutory Obviousness Double Patenting

Claims 29-35 were rejected for nonstatutory obviousness double patenting as being unpatentable over claims 29-48 of copending Application No. 11/157,198 ('198). A terminal disclosure is filed herewith to the '198 Application and therefore the Applicant respectfully requests the rejection be withdrawn.

In view of the foregoing, it is submitted that this application is in condition for allowance. Favorable consideration and prompt allowance of the application are respectfully requested.

The Examiner is invited to telephone the undersigned if the Examiner believes it would be useful to advance prosecution.

Respectfully submitted,



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